

NOTICE OF APPEAL TRANSMITTAL FORM

AF/2875/18

First Named Inventor	Wing Leung
Title	Decorative Globes
Serial No.	09/873,845
Filing Date	June 4, 2001
Examiner	Mark Tsidulko
Group Art Unit	2875
Attorney Docket Number	CHU/176/US
Date	October 7, 2003

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TRANSMITTAL OF APPEAL BRIEF (PATENT APPLICATION - 37 C.F.R. § 1.192(a))

1) Transmitted herewith, in triplicate, is the Appeal Brief in this application with respect to the Notice of Appeal filed on August 18, 2003.

2) STATUS OF APPLICANT: This application is on behalf of:

☐ Large Entity
☒ Small Entity

3) FEE FOR FILING APPEAL BRIEF

PURSUANT TO 37 C.F.R. §1.17(c), the fee for filing the Appeal Brief is:

☐ Large Entity \$330.00
☒ Small Entity \$165.00

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Signature

Date:

October 7, 2003

First Named Inventor	Title	Attorney Docket Number
Wing Leung	Decorative Globes	CHU/176/US

5) TOTAL FEE DUE

APPEAL BRIEF DUE: \$ 165.00

TOTAL FEE DUE: \$ 165.00

6) FEE PAYMENT

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7) FEE DEFICIENCY

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Respectfully Submitted,

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re reissue patent application of:
Wing Leung.

Serial No. 09/873,845

Group Art Unit: 2875

Filed: 06/04/2001

Examiner: Mark Tsidulko

For: Decorative Globes

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ATTENTION: Board of Patent Appeals and Interferences

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APPEAL BRIEF

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APPEAL BRIEF

This brief contains the following sections under the headings and in the order set forth below as required by (37 C.F.R. §1.192(c)):

- I. REAL PARTY IN INTEREST
- II. RELATED APPEALS AND INTERFERENCES
- III. STATUS OF CLAIMS
- IV. STATUS OF AMENDMENTS
- V. SUMMARY OF THE INVENTION
- VI. ISSUES
- VII. GROUPING OF CLAIMS (37 C.F.R. §1.192(c)(7))
- VIII. ARGUMENTS - REJECTIONS UNDER 35 U.S.C. §103 (37 C.F.R. §1.192(c)(8)(iv))
 - A. THE EXAMINER HAS THE BURDEN OF ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS WITHIN THE LEGAL REQUIREMENTS CREATED BY THE COURTS.
 - B. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS AGAINST CLAIMS 1-4.
 1. FARQUHAR DOES NOT TEACH OR SUGGEST THE FEATURES ASSERTED BY THE EXAMINER.
 2. THE FARQUHAR REFERENCE DOES NOT PROVIDE THE LEGALLY REQUIRED REASONABLE EXPECTATION OF SUCCESS REQUIRED TO ESTABLISH A *PRIMA FACIE* OBVIOUSNESS REJECTION.
 3. THE EXAMINER'S SUMMARY STATEMENTS DECLARING APPELLANTS' INVENTION OBVIOUS ARE LEGALLY INSUFFICIENT TO ESTABLISH A *PRIMA FACIE* OBVIOUSNESS REJECTION.
 - C. FARQUHAR DOES NOT TEACH OR SUGGEST ALL OF THE LIMITATIONS OF APPELLANT'S CLAIM 1.

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- D. FARQUHAR DOES NOT TEACH OR SUGGEST ALL OF THE LIMITATIONS OF APPELLANT'S CLAIM 2 AND 4.**
- E. FARQUHAR DOES NOT TEACH OR SUGGEST ALL OF THE LIMITATIONS OF APPELLANT'S CLAIM 3.**
- F. WHEN CONSIDERED AS A WHOLE THE FARQUHAR REFERENCE TEACHES AWAY FROM APPELLANT'S INVENTION AS EMBODIED IN CLAIMS 1-4.**

THE EXAMINER HAS RESORTED TO IMPERMISSIBLE HINDSIGHT TO FIND APPELLANT'S CLAIMS OBVIOUS OVER THE FARQUHAR REFERENCE.

- H. SINCE THE APPELLANT'S INVENTION IS NOT OBVIOUS IN VIEW OF THE APPLIED REFERENCE, THE REJECTION OF CLAIMS 1-4 SHOULD BE REVERSED.**

IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

The final page of section IX bears the signature of Appellant's attorney.

I. REAL PARTY IN INTEREST (37 C.F.R. §1.192(c)(1))

This application was assigned to Green Logic Associates Limited a British Virgin Islands Corporation having a principal place of business at P.O. Box 957, Offshore Incorporations Centre, Road Town, Tortola, British Virgin Islands. The assignment was recorded with the USPTO on 06/04/2001 and is located at Reel/Frame 011885/0976 in three (3) pages.

II. RELATED APPEALS AND INTERFERENCES (37 C.F.R. §1.192(c)(2))

There are no known appeals or interferences related to this application.

III. STATUS OF CLAIMS (37 C.F.R. §1.192(c)(3))

a. TOTAL NUMBER OF CLAIMS IN THIS APPLICATION

CLAIMS IN THIS APPLICATION NUMBER: 4

b. STATUS OF ALL CLAIMS

CLAIMS 1-4 ARE REJECTED.

c. CLAIMS ON APPEAL

THE CLAIMS ON APPEAL ARE CLAIMS 1-4.

IV. STATUS OF AMENDMENT (37 C.F.R. §1.192(c)(4))

The application 09/873,845 was filed on June 4, 2001 with claims 1-4, which have not been amended.

V. SUMMARY OF THE INVENTION (37 C.F.R. §1.192(c)(5))

Briefly stated, one embodiment of Appellant's invention is an illuminated decorative globe having an outer translucent cover 10 which forms an enclosure for an inner globe 11. The inner globe is supported by a rotatable frame 13.¹ The inner globe 11 has in its center a light bulb 15 that operates as a light source. The inner globe 11 has disposed on it markings such as a world map (Figure 2). The light from the light bulb 15 passes through the inner globe 11 and projects an image corresponding to the markings on the inner globe onto an inner surface of the outer translucent cover 10. The projected image is visible from the exterior of the translucent cover 10.

¹ Appellant notes that while preparing this Appeal Brief, a clerical error was found in claim 1, at line 3 wherein the word "rotatably" should correctly read and be replaced with the word "rotatable"

VI. ISSUES (37 C.F.R. §1.192(c)(6))

- (1) Whether claims 1,2,3, and 4 are patentable under 35 U.S.C. §103(a) over United States Patent No. 3,303,582 to Farquhar.
- (2) Whether claim 3 is patentable under 35 U.S.C. §103(a) over United States Patent No. 3,303,582 to Farquhar in view of United States Patent No. 6,039,453 to Wang.

VII. GROUPING OF CLAIMS (37 C.F.R. §1.192(c)(7))

Claims 1, 2, and 4 stand together.

Claim 3 stands alone.

VII ARGUMENTS - REJECTIONS UNDER 35 U.S.C. §103(a) (37 C.F.R. §1.192(c)(8)(iv))

A. THE EXAMINER HAS THE BURDEN OF ESTABLISHING A *PRIMA FACIE* CASE OF OBVIOUSNESS WITHIN THE LEGAL REQUIREMENTS CREATED BY THE COURTS.

The courts have established the legal concept of *prima facie* obviousness. As summarized in MPEP §2142, "The legal concept of *prima facie* obviousness is a procedural tool of examination which . . . allocates who has the burden of going forward with production of evidence in each step of the examination process." The MPEP further states "The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness. If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness."

To establish a *prima facie* case of obviousness three basic criteria must be met. First there must be some suggestion or motivation, either in the references themselves or

in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See M.P.E.P. §2143.

It is indisputable that in order to properly reach a conclusion as to obviousness, pertinent case law requires that "there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination." Interconnect Planning Corp., v. Fell, 227 USPQ 543, 551 (Fed. Cir. 1985). In determining the differences between the prior art and the claims, the question under 35 U.S.C. §103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. Stratoflex, Inc. v. Aeroquip Corp., 218 USPQ 871 (Fed. Cir. 1983). Furthermore, the prior art reference must be considered in its entirety, including portions that would lead away from the claimed invention. W.L. Gore & Associates, Inc. v. Garlock, Inc., 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); see also M.P.E.P. §2141.02. The burden is on the Examiner to demonstrate that the prior art evidences sufficient suggestion of the desirability of doing what the inventor has done. See M.P.E.P. §2142. At an irreducible minimum, this burden requires this Examiner to apply the facts of the case to "present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references." Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985). Clearly, the Examiner cannot discharge himself from this burden by simply declaring all of the elements of an invention, along with the manner of

combining these elements, to be well known in the art. Ex parte Stern, 13 USPQ2d 1379, 1381 (Bd. Pat. App. & Inter. 1989).

B. THE EXAMINER HAS FAILED TO ESTABLISH A *PRIMA FACIE* CASE OF OBVIOUSNESS AGAINST CLAIM 1.

1. FARQUHAR DOES NOT TEACH OR SUGGEST THE FEATURES ASSERTED BY THE EXAMINER.

Farquhar does not teach or suggest, at least, an image that is projected onto an inner surface of an outer cover and is visible from outside the outer cover. Farquhar to the contrary teaches projecting an image created from passing light through an inner globe 100 and an outer globe 20. Farquhar, column 5, lines 13-15. The Farquhar image is projected from these two globes and is displayed on a viewing surface 8. The Farquhar viewing surface 8 is positioned such that when a “celestial scene is projected chairs may be positioned around the stand so that the viewer can see above him the projected image...”. Farquhar, column 2, lines 44-47. This is clearly not an image that is projected onto an inner surface of an outer cover and is visible from outside the outer cover. The Examiner in making the rejection has simply failed to appreciate that the explicit teaching of Farquhar is to project an image to an interior surface of a viewing surface such that the image is visible only on this surface from an interior position. Since, at least, this element is not present a proper *prima facie* case for obviousness has clearly not been established and the Examiners rejection must be reversed.

2. THE FARQUHAR REFERENCE DOES NOT PROVIDE THE LEGALLY REQUIRED REASONABLE EXPECTATION OF SUCCESS REQUIRED TO ESTABLISH A *PRIMA FACIE* OBVIOUSNESS REJECTION.

Obviousness does not require absolute predictability, however at least some degree of predictability is required. Evidence showing there was no reasonable expectation of success may support a conclusion of nonobviousness. MPEP §2143.02 citing In re Rinehart, 189 USPQ 143 (CCPA 1976). Farquhar does not teach or suggest an image that is projected onto an inner surface of an outer cover and is visible from outside the outer cover. Further, Farquhar teaches projecting an image created from passing light through an inner globe 100 and an outer globe 20. Farquhar, column 5, lines 13-15. The Farquhar image projected from these two globes is displayed on a viewing surface 8. The Farquhar viewing surface 8 is positioned such that when a “celestial scene is projected chairs may be positioned around the stand so that the viewer can see above him the projected image on the hemispherical surface” Farquhar, column 2, lines 44-47. This is clearly not an image that is projected onto an inner surface of an outer cover and is visible from outside the outer cover. The Examiner in making the rejection has simply failed to appreciate that the explicit teaching of Farquhar is to project an image to an interior surface of a viewing surface such that the image is visible only on this surface from an interior position. It is clear that a person of ordinary skill in the art would have no reasonable expectation of success in modifying the Farquhar system away from the explicitly taught device to reach Appellant’s claimed invention.

3. THE EXAMINER'S SUMMARY STATEMENTS DECLARING APPELLANT'S INVENTION OBVIOUS ARE LEGALLY INSUFFICIENT TO ESTABLISH A *PRIMA FACIE* OBVIOUSNESS REJECTION.

In the Office Action mailed May 21, 2003 the Examiner stated beginning with the last paragraph on page 2 of the Office Action, that Farquhar discloses an image "Projected onto an inner surface of the outer cover and is visible from outside the outer cover (col. 6, lines 30-35). The cited Farquhar passage clearly is counter to the Examiner's statement. The passage states "Projecting . . . information . . . from (emphasis added) transparent globes . . . ". Farquhar, column 6, lines 31-33. The Examiner further stated in the third paragraph of the Response to Arguments section that "it is understood that the image is projected onto inner surface of an outer cover owing to light source inside of the inner globe...". This statement simply asserts that the element is present contrary to the teaching of Farquhar. Farquhar is clear that the device may display "preselected celestial or terrestrial information printed" on transparent globes or may display projected images on a remote surface. Farquhar column 1, lines 14-18.

As noted in MPEP §2142 the burden is on the Examiner to demonstrate that the prior art evidences sufficient suggestion of the desirability of doing what the inventor has done. Further, the courts have stated that the Examiner cannot discharge himself from this burden by simply declaring all of the elements of an invention, along with the manner of combining these elements, to be well known in the art. Ex parte Stern, 13 USPQ2d 1379, 1381 (Bd. Pat. App. & Inter. 1989). The Examiner's cursory and unsupported statements clearly do not meet the legally required standard stated by the Stern court and are legally insufficient to establish a *prima facie* obviousness rejection of Appellants' claims 1-4.

C. FARQUHAR DOES NOT TEACH OR SUGGEST ALL OF THE LIMITATIONS OF APPELLANT'S CLAIM 1.

Claim 1 recites in pertinent part an image is projected onto an inner surface of an outer cover and is visible from outside the outer cover. The Examiner has not pointed to a passage in the Farquhar reference that teaches or suggests this feature. In fact, as stated in Farquhar at column 6, lines 31-33, the "invention disclosed herein above relates to . . . projecting . . . information . . . from (emphasis added) transparent globes . . . ". It is therefore clear that the disclosure of Farquhar not only does not disclose Appellant's invention as embodied in claim 1, but also teaches away from Appellant's invention as embodied in claim 1

D. FARQUHAR DOES NOT TEACH OR SUGGEST ALL OF THE LIMITATIONS OF APPELLANT'S CLAIMS 2 and 4 .

Claims 2, and 4 depend directly on claim 1. The Examiner has not pointed to a passage in the Farquhar reference that teaches or suggests an image projected onto an inner surface of an outer cover and is visible from outside the outer cover. As such, a proper rejection of claims 2 and 4 under 35 U.S.C. §103 has not been made.

For at least these reasons a proper *prima facie* case for obviousness has clearly not been established for claims 2 and 4 and the Examiner's rejection of these claims must be reversed.

E. FARQUHAR DOES NOT TEACH OR SUGGEST ALL OF THE LIMITATIONS OF APPELLANT'S CLAIM 3.

Claim 3 is patentable under 35 U.S.C. §103(a) over United States Patent No. 3,303,582 to Farquhar in view of United States Patent No. 6,039,453 to Wang since claim 3 depends directly on claim 1. The Examiner has not pointed to a passage in the Farquhar or Wang references that teach or suggest an image projected onto an inner

surface of an outer cover and is visible from outside the outer cover. The rejection of claim 3 is improper for at least the reason that all the claimed elements are not present in the asserted combination.

For at least these reasons a proper *prima facie* case for obviousness has clearly not been established for claim 3 and the Examiner's rejection of this claim must be reversed.

F. WHEN CONSIDERED AS A WHOLE THE FARQUHAR REFERENCE TEACHES AWAY FROM APPELLANT'S INVENTION AS EMBODIED IN CLAIM 1.

As previously discussed, there is no disclosure in Farquhar whatsoever of an image that is projected onto an inner surface of an outer cover and is visible from outside the outer cover. The Farquhar reference clearly teaches two modes of display. For example, in column 1, lines 14– 18 Farquhar is clear that the device may display "preselected celestial or terrestrial information printed" on transparent globes or may display projected images on a remote surface. Farquhar simply does not teach or suggest projecting an image to an inner surface of an outer cover the image then being visible from outside the outer cover. The teachings of Farquhar to provide either globes with printed images or images which are projected onto a remote surface. This teaching is contrary to and teaches away from Appellants' invention of an image that is projected onto an inner surface of an outer cover and is visible from outside the outer cover the outer cover being translucent.

G. THE EXAMINER HAS RESORTED TO IMPERMISSIBLE HINDSIGHT TO FIND APPELLANTS' CLAIMS OBVIOUS OVER THE FARQUHAR REFERENCE.

35 U.S.C. §103 specifies that the obviousness of an invention is to be determined as of "the time the invention was made." This requires the Examiner to step backward in

time and into the shoes worn by the hypothetical person of ordinary skill in the art when the invention was unknown and just before it was made. MPEP §2142. "When applying 35 U.S.C. 103, . . . the references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention . . ." Hodosh v. Block Drug Co., Inc., 229 USPQ 182, 187, n5 (Fed. Cir. 1986). The court has further stated "a retrospective view of inherency is not a substitute for some teaching or suggestion supporting an obviousness rejection. In re Rijkaert, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) citing In re Newell, 13 USPQ2d 1248, 1250 (Fed. Cir. 1989). The Farquhar reference is silent concerning an image which is projected onto an inner surface of an outer cover and is visible from outside the outer cover. The Examiner has not provided any teaching or suggestion within the Farquhar reference that could teach or suggest an image which is projected onto an inner surface of an outer cover and is visible from outside the outer cover in Farquhar. In fact, the only route to discover the alleged image which is projected onto an inner surface of an outer cover and is visible from outside the outer cover from the silent teachings of Farquhar is by impermissibly using Appellants' invention as a blueprint.

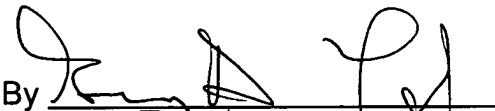
H. SINCE THE APPELLANT'S INVENTION IS NOT OBVIOUS IN VIEW OF THE APPLIED REFERENCE, THE REJECTION OF CLAIMS 1-4 SHOULD BE REVERSED.

In the present rejections, the Examiner has interpreted the disclosures of his reference in a manner contrary to the disclosure within the references and within the art to find features that do not, and cannot, exist. The Examiner then combines these features, with no convincing showing of any suggestion or motivation for this combination. Even with improperly combined references, the Examiner's combination fails to teach or suggest all of the limitations of Appellants' claims. Since the Examiner has failed to meet

the legal burden necessary to support a *prima facie* case of obviousness, the rejections of claims 1-4 should be reversed.

Respectfully submitted,

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IX. APPENDIX OF CLAIMS INVOLVED IN THE APPEAL

1. An illuminated decorative globe having an outer translucent cover forming an enclosure for an inner globe carrying an image on its surface, a rotatably mounting supporting the inner globe and an electric light bulb inside the inner globe, and an electric motor coupled to rotate the mounting such that the image is projected onto an inner surface of the outer cover and is visible from outside the cover.
2. An illuminated decorative globe according to claim 1, in which the outer cover and inner globe are spherical.
3. An illuminated decorative globe according to claim 1, in which the outer cover has an aperture in its base through which the inner globe may pass during assembly of the decorative globe.
4. An illuminated decorative globe according to claim 1, in which the image is a map of the world.

* * * * *